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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.	
09/964,389	09/28/2001	Mark Kirkpatrick	BS01-290	2348	
45695 7590 09/16/2005			EXAMINER		
	KEYS FOR BELL SOU	ENG, GEORGE			
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,			2643		
			DATE MAILED: 09/16/2005		

Please find below and/or attached an Office communication concerning this application or proceeding.

		Application	on No.	Applicant(s)			
Office Action Summary		09/964,38	39	KIRKPATRICK, MARK			
		Examiner		Art Unit			
		George E	ng	2643			
The MAILING DATE of this communication appears on the cover sheet with the correspondence address Period for Reply							
A SH WHIC - Exter after - If NC - Failu Any	ORTENED STATUTORY PERIOD FOR RECHEVER IS LONGER, FROM THE MAILING IS IN (6) MONTHS from the mailing date of this communication of the reply is specified above, the maximum statutory re to reply within the set or extended period for reply will, by reply received by the Office later than three months after the department adjustment. See 37 CFR 1.704(b).	NG DATE OF TH CFR 1.136(a). In no evo on. period will apply and wi statute, cause the app	HIS COMMUNICATION The state of	DN. timely filed m the mailing date of this o IED (35 U.S.C. § 133).	•		
Status							
1)	Responsive to communication(s) filed on	30 June 2005.					
-		This action is n	on-final.				
3)	Since this application is in condition for al	llowance except	for formal matters, p	rosecution as to the	e merits is		
	closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11, 453 O.G. 213.						
Dispositi	on of Claims						
4)⊠	4)⊠ Claim(s) <u>1-3,5-10,12-14 and 16-28</u> is/are pending in the application.						
	4a) Of the above claim(s) is/are withdrawn from consideration.						
5)□	5) Claim(s) is/are allowed.						
6)⊠	☑ Claim(s) <u>1-3,5-10,12-14 and 16-28</u> is/are rejected.						
7)	Claim(s) is/are objected to.						
8)[Claim(s) are subject to restriction a	and/or election re	equirement.				
Applicati	on Papers						
9)[The specification is objected to by the Exa	aminer.					
10)	The drawing(s) filed on is/are: a)] accepted or b)	objected to by the	Examiner.			
	Applicant may not request that any objection t	to the drawing(s) b	e held in abeyance. So	ee 37 CFR 1.85(a).			
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).							
11)	The oath or declaration is objected to by t	he Examiner. No	te the attached Offic	e Action or form PT	ΓΟ-152.		
Priority u	ınder 35 U.S.C. § 119						
12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f). a) All b) Some * c) None of:							
	1. Certified copies of the priority documents have been received.						
	2. Certified copies of the priority documents have been received in Application No						
	3. Copies of the certified copies of the priority documents have been received in this National Stage						
	application from the International Bureau (PCT Rule 17.2(a)).						
* See the attached detailed Office action for a list of the certified copies not received.							
Attachmen	t(s)						
1) Notice of References Cited (PTO-892) 4) Interview Summary (PTO-413)							
2) Notice of Draftsperson's Patent Drawing Review (PTO-948) 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date 5) Notice of Informal Patent Application					D-152)		
Paper No(s)/Mail Date 6) Other:					J 102)		

DETAILED ACTION

Response to Amendment

- 1. This Office action is in response to the amendment filed 6/30/2005. Accordingly, claims
- 4, 11 and 15 are cancelled and claims 1-3, 5-10, 12-14 and 16-28 are pending for examination.

Double Patenting

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 1-28 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-20 of copending Application No. 09/964,385 and claims 1-20 of copending Application No. 10/101,630. Although the conflicting claims are not identical, they are not patentably distinct from each other because all the claimed limitations, i.e., a battery and a sound generating device, are transparently found in the copending Application No. 09/964,385 and copending Application No.

Art Unit: 2643

10/101,630 with obvious wording variations. See the following example of claim 1 of present application, copending Application No. 09/964,385 and copending Application No. 10/101,630.

Application 09/964,389	Application 09/964,385	Application 10/101,630	
A device that plays alerts and is used with a wireless communications device,	A battery assembly system for a cellular telephone,	A battery assembly system for a cellular telephone,	
a substantially rectangular planer shell having electrical terminals on one side that are electrically connectable to electrical terminal on the wireless communication device,	a first battery for providing power to the cellular telephone,	a first battery for providing power to the cellular telephone,	
an alert generating device located inside the shell and electrically connected to the electrical connectors of the planner shell, comprising a memory for storing an alert file, wherein the alert generating device is triggered to play an alert associated with the alert file upon detection of an incoming communication by the wireless communication device.	a first sound generating device attached to the first battery and comprising a memory for storing a first sound file, wherein the first sound generating device is triggered to play sound associated with the first sound file when the first battery is installed in the cellular telephone upon detection of a telephone call by the cellular telephone.	a first sound generating device attached to the first battery and comprising a memory for storing a first sound file downloaded from a removable memory device attachable to the first battery, wherein the first sound generating device is triggered to play sound associated with the first sound file when the first battery is installed in the cellular telephone upon detection of a telephone call by the cellular telephone.	

This is a <u>provisional</u> obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

Art Unit: 2643

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 5-6 and 21 are rejected under 35 U.S.C. 102(b) as being anticipated by Stone (US

PAT. 5,767,778).

Regarding claim 5, Stone discloses a device (31, figure 4) for a wireless communication device (32, figure 4) that plays alerts, the device comprising a shell (13, figure 3) attachable between a wireless communications device body (11, figure 3) and a wireless communications device battery (12, figure 3), an alert generating device (38, figure 4) inside the shell and comprising memory (42, figure 40) for storing a plurality of alert files, wherein the alert generating device is triggered by an electrical signal from the wireless communication device (32, figure 4) to play an alert associated with the alert file upon detection of incoming communication by the wireless communications device, an external connector socket (43, figure 4) on the shell in electrical communication with the alert generating device to provide external access to the plurality of alert files in the alert generating device and a selector, i.e., a mode switch, on the shell for designating a file to use as an audio alert (col. 4 line 13 through col. 5 line 35 and col. 7 lines 10-31).

Regarding claim 6, the limitations of the claim are rejected as the same reasons set forth in claim 5.

Regarding claim 21, Stone discloses a computer readable medium containing instructions that when executed by a processor of a wireless device perform acts, wherein the cellular telephone includes a cellular telephone body (32, figure 4) for generating an electrical signal, a

cellular telephone battery (30, figure 4) for powering the cellular telephone body, an audio signal device (31, figure 4) connectable with the cellular telephone body and the cellular telephone battery, including a sound generating device (38, figure 4), memory (42, figure 4), and a selector device (41, figure 4), comprising the acts of storing a plurality of sound files in memory, receiving input from the selector device, designating a file of the plurality to use as an alert signal by manipulating the selector on the audio signal device and alerting a user with the alert signal of the designated file in response to the electrical signal generated by the body (abstract and col. 4 line 13 through col. 5 line 35 and col. 7 lines 10-31).

Claim Rejections - 35 USC § 103

- 6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:
 - (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.
- 7. Claims 1-3, 7-10, 12-14, 16-20 and 22-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stone (US PAT. 5,767,778 hereinafter Stone) in view of Haraguchi (US PAT. 6,597,279).

Regarding claim 1, Stone discloses a device (31, figure 4) that plays alerts and is used with a wireless communications device (32, figure 4), the device comprising: a substantially rectangular planar shell having electrical terminals (14b and 15c, figure 3) on one side that are electrically connectable to electrical terminals (14a and 15a, figure 3) on a wireless

Application/Control Number: 09/964,389

Art Unit: 2643

communications device, and an alert generating device (38, figure 4) located inside the shell and electrically connected to the electrical connectors of the planar shell, comprising memory (42, figure 42) for storing an alert file, wherein the alert generating device is triggered to play an alert associated with the alert file upon detection of incoming communication by the wireless communications device (col. 4 line 13 through col. 5 line 35 and col. 7 lines 10-31). In addition, Stone teaches a selector device, i.e., a mode switch, on the rectangular planar shell for determining the type of auxiliary alert to be generated (col. 5 lines 10-25 and col. 7 lines 16-20). Stone differs from the claimed invention in not specifically teaching the selector device for scrolling through the plurality of sound files and designating a sound file to use as an audio alert signal. However, Haraguchi teaches a simplified method for setting an incoming tone to be output from a speaker when a signal is received by an operation comprising a jog dial for scrolling through the plurality of sound files and designating a sound file to use as an audio alert signal (col. 5 lines 6 through col. 6 line 34) in order to simplify the operation of setting the incoming tone. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the selector device of Stone for scrolling through the plurality of sound files and designating a sound file to use as an audio alert signal, as per teaching of Haraguchi, because it makes user friendly by simplifying the operation of setting the incoming tone.

Regarding claim 2, Stone discloses the alert generating device being a sound generating device (col. 7 lines 13-14), wherein the alert file is a sound file and the alert is an audio alert (col. 7 lines 26-28), and wherein the sound generating device stores a plurality of sound files, and

wherein each sound file can be designated as an audio alert signal for the telephone (col. 7 lines 28-31).

Regarding claim 3, Stone teaches an external connector socket in electrical communication to provide external access to the plurality of sound files in the sound generating device (col. 7 lines 21-23).

Regarding claim 7, Stone discloses a wireless communications device system having changeable alert signals, the system comprising a wireless communications device body (11. figure 3) a wireless communications device battery (12, figure 3) for powering the wireless communications device body; and an alert signal device (31, figure 4) connectable with the wireless communications device body and the wireless communications device battery, including an alert generating device (38, figure 4) comprising memory (42, figure 4) for storing an alert file, wherein the alert generating device is triggered to play an alert associated with the alert file upon detection of incoming communication by the wireless communications device (col. 4 line 13 through col. 5 line 35 and col. 7 lines 10-31). In addition, Stone teaches a selector device, i.e., a mode switch, on the rectangular planar shell for determining the type of auxiliary alert to be generated (col. 5 lines 10-25 and col. 7 lines 16-20). Stone differs from the claimed invention in not specifically teaching the selector device for scrolling through the plurality of sound files and designating a sound file to use as an audio alert signal. However, Haraguchi teaches a simplified method for setting an incoming tone to be output from a speaker when a signal is received by an operation comprising a jog dial for scrolling through the plurality of sound files and designating a sound file to use as an audio alert signal (col. 5 lines16 through col. 6 line 34) in order to simplify the operation of setting the incoming tone. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the selector device of Stone for scrolling through the plurality of sound files and designating a sound file to use as an audio alert signal, as per teaching of Haraguchi, because it makes user friendly by simplifying the operation of setting the incoming tone.

Regarding claim 8, the limitations of the claim are rejected as the same reasons set forth in claim 2.

Regarding claims 9-10, Stone teaches an external connector socket (43, figure 4) in electrical communication to provide external access to the plurality of sound files in the sound generating device such that a computer system includes an electrical plug connected to the sound generating device through the connector socket for editing the plurality of sound files by adding or deleting from the sound generating device (col. 7 lines 16-23).

Regarding claim 12, Stone teaches the alert generating device being a sound generating device (col. 7 lines 13-14), wherein the alert file is a sound file and the alert is an audio alert (col. 7 lines 26-28), and wherein the sound generating device stores a plurality of sound files that are capable of being edit (col. 7 lines 18-23).

Regarding claims 13-14, the limitations of the claims are rejected as the same reasons set forth in claims 9-10.

Regarding claims 16 and 17, Stone discloses the system comprising an external connector, i.e., accessing means (43, figure 4), on the audio signal device in electrical communication with the sound generating device to provide external access to the plurality of sound files in the sound generating device, a computer system, i.e., programming means, having an electrical plug electrically connected to the sound generating device through the connector

socket, for editing the plurality of sound files by adding or deleting from the sound generating device, and a selector device, i.e., selecting means (41, figure 4) on the audio signal device for designating a sound file to use as an audio alert signal (col. 5 lines 10-25 and col.7 lines 10-31).

Regarding claim 18, Stone discloses a method of programming designating alert signals on a wireless communication device comprising the steps of providing an alert signal device (31, figure 4) for use with a wireless communications device (32, figure 4), the alert signal device including a programmable alert generating device (38, figure 4) and an external socket (43, figure 4) located on an outside surface, connecting a computer system containing software that can access the alert generating device to the external socket of the audio alert signal device. accessing the alert generating device, adding or deleting an alert file via the computer onto or from the alert generating device, respectively (col. 4 line 13 through col. 5 line 35 and col. 7 lines 10-31). In addition, Stone teaches a selector device, i.e., a mode switch, on the rectangular planar shell for determining the type of auxiliary alert to be generated (col. 5 lines 10-25 and col. 7 lines 16-20) so that one skill in the art would recognize the selector device located on the outside surface. Stone differs from the claimed invention in not specifically teaching the selector device for scrolling through the plurality of sound files and designating a sound file to use as an audio alert signal. However, Haraguchi teaches a simplified method for setting an incoming tone to be output from a speaker when a signal is received by an operation comprising a jog dial for scrolling through the plurality of sound files and designating a sound file to use as an audio alert signal (col. 5 lines 6 through col. 6 line 34) in order to simplify the operation of setting the incoming tone. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the selector device of Stone for scrolling through the

plurality of sound files and designating a sound file to use as an audio alert signal, as per teaching of Haraguchi, because it makes user friendly by simplifying the operation of setting the incoming tone.

Regarding claim 19, Stone teaches that the computer system is a PC, which is inherently including a personal data assistant (col. 7 lines 21-23).

Regarding claim 20, Stone discloses a method of selecting a designating alert signals on a wireless communication device (32. figure 4) comprising the steps of providing an alert signal device (31, figure 4) for use with a wireless communications device (32, figure 4), the alert signal device including a programmable alert generating device (38, figure 4) and a selector (41, figure 4) located on an outside surface, wherein the alert generating device includes a plurality of alert files, and selecting a selected alert from the plurality of alert files when a designated alert filed is reached (col. 4 line 13 through col. 5 line 35 and col. 7 lines 10-31). Stone differs from the claimed invention in not specifically teaching the step of scrolling through the plurality of sound files with the selector to experience the plurality of alert file. However, Haraguchi teaches a simplified method for setting an incoming tone to be output from a speaker when a signal is received by an operation comprising a jog dial for scrolling through the plurality of sound files and designating a sound file to use as an audio alert signal (col. 5 lines 16 through col. 6 line 34) in order to simplify the operation of setting the incoming tone. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify Stone in scrolling through the plurality of sound files with the selector to experience the plurality of alert file, as per teaching of Haraguchi, because it makes user friendly by simplifying the operation of setting the incoming tone.

Art Unit: 2643

Regarding claims 22-24, Stone discloses that the wireless device is a cellular telephone (32, figure 4), the alert is a sound (col.7 liens 13-14) and the incoming communication is a telephone call (col. 2 lines 9-23).

8. Claims 25-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stone (US PAT. 5,767,778 hereinafter Stone) in view of Haraguchi (US PAT. 6,597,279) and Sawada et al. (US PAT. 6,810,274 hereinafter Sawada).

Regarding claim 25, Stone discloses a device (13, figure 3) that plays alerts and is used with a wireless communications device (11, figure 3), the device comprising a planar shell having electrical terminals (14b and 15b, figure 3) on one side that are electrically connectable to electrical terminals (14a and 15a, figure 3) on a wireless communications device, and an alert generating device (38,, figure 4), located inside the shell and electrically connected to the electrical connectors of the planar shell, comprising memory (42, figure 4) for storing an alert file, wherein the alert generating device is triggered to play an alert associated with the alert file upon detection of an incoming communication by the wireless communications device. In addition, Stone teaches a selector device, i.e., a mode switch, on the rectangular planar shell for determining the type of auxiliary alert to be generated (col. 5 lines 10-25 and col. 7 lines 16-20). Stone differs from the claimed invention in not specifically teaching the selector device for scrolling through the plurality of sound files and designating a sound file to use as an audio alert signal. However, Haraguchi teaches a simplified method for setting an incoming tone to be output from a speaker when a signal is received by an operation comprising a jog dial for scrolling through the plurality of sound files and designating a sound file to use as an audio alert

signal (col. 5 lines 16 through col. 6 line 34) in order to simplify the operation of setting the incoming tone. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the selector device of Stone for scrolling through the plurality of sound files and designating a sound file to use as an audio alert signal, as per teaching of Haraguchi, because it makes user friendly by simplifying the operation of setting the incoming tone. Furthermore, neither Stone nor Haraguchi specifically teaching the alert generating device comprising a memory receiving slot for adding new alert signal from a second memory positioned within the memory receive slot. However, Sawada teaches a battery pack (2, figure 1) supplying the portable telephone unit (1, figure 1) with electrical power having a removable IC card having semiconductor memory (3, figure 1) and an audio device (38, figure 8) having a memory receiving slot (5, figure 2) for adding new alert signals from a second memory positioned within the memory receiving slot (col. 3 lines 16-24 and col. 4 line 60 through col. 5 line 10) in order to reduce size. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify Stone in having the alert generating device further comprising the memory receiving slot for adding new alert signal from a second memory positioned within the memory receive slot, as per teaching of Sawada, because it reduces size of the device.

Regarding claim 26, Stone discloses that the wireless device is a cellular telephone (32, figure 4), the alert is a sound (col.7 liens 13-14) and the incoming communication is a telephone call (col. 2 lines 9-23).

Regarding claim 27, the limitations of the claim are rejected as the same reasons as set forth in claim 25.

Regarding claim 28, the limitations of the claim are rejected as the same reasons as set forth in claim 26.

Response to Arguments

- 9. Applicant's arguments with respect to claims 1-3, 7-10, 12-14, 16-20 and 22-28 have been considered but are most in view of the new ground(s) of rejection.
- 10. Applicant's arguments filed 6/30/2005 have been fully considered but they are not persuasive.

In response to applicant's argument that Stone does not disclose a selector on the shell, it is noted that Stone clearly teaches a mode switch (41, figure 4) read as a selector for allowing a user to determine the type of auxiliary alert to be generated (col. 5 lines 10-14), where the selector is located on the event sensor and alert generator (31, figure 4) read as a ringing device. Thus, Stone in combination of Haraguchi teaches the claimed limitations.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., the sensing circuit being located in the body of the communication device) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). In addition, Stone clearly teaches an alert generator (31, figure 4) outside the body of a wireless communication device (32, figure 4) being triggered by an

electrical signal, i.e., power consumption values, from the wireless communication device body (col. 5 line 36 through col. 6 line 5). Thus, claims 5, 6 and 21 are rejected under Stone.

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Stone clearly teaches a mode switch (41, figure 4) read as a selector for allowing a user to determine the type of auxiliary alert to be generated (col. 5 lines 10-14), where the selector is located on the event sensor and alert generator (31, figure 4) read as a ringing device, and the use of Haraguchi is merely for teaching to modify the selector as a jog dial for scrolling through the plurality of sound files and designating a sound file because Haraguchi clearly teaches the use of jog dial simplifying a selection operation (col. 1 lines 45-50 and col. 5 line 16 through col. 6 line 34). Thus, one skill in the art would recognize to combine the teaching of Haraguchi in Stone in order to simplify the selection operation.

Art Unit: 2643

Conclusion

11. THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to George Eng whose telephone number is 703-308-9555. The examiner can normally be reached on Tue-Fri 7:30 AM-6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Curtis A. Kuntz can be reached on 703-305-4708. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 2643

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

George Eng

Primary Examiner Art Unit 2643